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REMARKS

Claims 3-20 remain in this application.

The Office Action requires election of one of the following: Species I, drawn to claims 3-12; and Species II, drawn to claims 13-20. In order to be responsive applicant elects Species I and traverses the restriction requirement as follows.

TRAVERSAL OF RESTRICTION OF SPECIES REQUIREMENT

Applicant traverses the restriction requirement as applied to Species I-II on two grounds. First, the restriction presented fails to properly state a case for restriction. Second, the species are so closely related that a search in either Species would essentially be identical and not present a serious burden on the Examiner.

A. Office Action does not satisfy requirements for setting forth a restriction requirement.

The MPEP specifically requires that, in making a restriction rejection requiring election of species, the Examiner state both reasons for distinctiveness and reasons establishing why examination of all claims would present a "serious burden" on the Examiner. In particular, MPEP §808.01 (8th Ed., Rev. 5) states the following with regard to establishing distinctiveness:

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The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

In making the present rejection it is respectfully submitted that the Examiner has not stated substantive reasons for the distinctiveness of the species proposed by the Examiner.

In the restriction, the Examiner is making distinction based on form of wording and not substance. The Examiner claims that claim 3 is directed to removing active material from "rail shaped protrusions" (claim 3 actually recites "a rail shaped protrusion") while claim 13 is directed to removing active material from "an impregnated core substrate defined by rail shaped protrusions." This does not set forth a distinction because claim 3 states:

press working a first surface of said active material
impregnated core substrate to form a rail shaped protrusion
protruding above pressed portions and defining boundaries with said
pressed portions.

Hence, the rail shaped protrusions inherently are a portion of the "impregnated core substrate" of claim 13 that are formed into rails. Claim 13 specifically relate that the "impregnated core substrate [is] defined by rail shaped protrusions."

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Hence, a mere conclusion is stated and a proper restriction is not set forth.

Still further, it is necessary that a serious burden on the Examiner be established. MPEP §808.01(a) specifically states:

A requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required. See MPEP § 803 and § 808.02.

Where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

In the present invention claims, each recites in essence that the active material is removed from rail shaped protrusions. Hence, a relationship is set forth. The Examiner has not stated any reasons why examination of all the claims presents a serious burden on the Examiner. Therefore, a proper restriction has not been set forth in view of this deficiency in addition to the above noted lack of statement of sufficient reasons for the distinctiveness.

Since a proper grounds for restriction is not set forth, applicant respectfully submits that it would be improper to make any Office Action issued in response to this reply final with regard to the restriction since applicant has not had the opportunity to reply to reasons necessary for the Examiner to make the restriction in the first place. It is further submitted that the lack of proper

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statement of reasons supporting the restriction requirement is indicative of the inappropriateness of such a requirement.

B. Claims pending do not present a serious burden to the Examiner and thus are not subject to restriction.

Applicant further submits that the present claims cannot be restricted because it cannot be established that they present a serious burden on the Examiner. This lack of burden is clearly established by the above coincidence of subject matter of the claims. It is respectfully submitted that removal of active material from rail shaped protrusions is included in the claim 13 recitation of removing active material from an impregnated core substrate because the impregnated core substrate of claim 13 is defined by rail shaped protrusions. Therefore, both claim 1 and claim 13 require the removal of active material from rail shaped protrusion. In view of this similarity, it is submitted that the Examiner's examination and rejection of each of the pending claims on the merits would certainly not present a serious burden.

"If the search and examination of **>all the claims in an< application can be made without serious burden, the examiner must examine *>them< on the merits, even though **>they include< claims to independent or distinct inventions." MPEP §803 (8th Ed., Rev. 5) Hence, it is submitted that consideration of all claims in the application is required because it cannot be said to present a

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serious burden. Clearly, prosecution of a divisional application resulting from the restriction would result in a duplication of effort by personnel of the Patent Office.

In view of the fact that the claims in question here have related subject matter and in view of the requirements set forth by the MPEP, reconsideration of the restriction requirement is respectfully requested and withdrawal of this restriction is respectfully requested.

GENERIC CLAIM

Claim 3 is to be considered generic. This is demonstrated by the dependency of claim 11 from claim 3 which recites the language of the form of claim 13.

In view of the above, reconsideration and withdrawal of the restriction requirement are respectfully requested.

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NO FEE DUE

No fee is believed due. If there is any fee due the USPTO is hereby authorized to charge such fee to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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